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Paper No. 3

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MAY 07 2001

**OFFICE OF PETITIONS
AC PATENTS**

In re Application of :
Reid et al. :
Application No. 09/739,933 : DECISION REFUSING STATUS
Filed: 18 December, 2000 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 07306-021001 :

This is in response to the renewed petition under 37 CFR 1.47(a)¹ filed on 18 December, 2000.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION. Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 18 December, 2000, naming James S. Reid and James H. Fallon as joint inventors, with

¹A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

a declaration signed by joint inventor Fallon. The present petition was also filed on 18 December, 2000.

Petitioners assert that the application papers were presented to joint inventor Reid, but that Reid has refused to execute the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C.

§§ 115 and 116;

(3) the petition fee; and

(4) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2).

In regards to item (1), the petition does not present a sufficient showing of proof that a copy of the application papers were sent or given to the non-signing inventor for review.² Petitioners states that the application was mailed to Reid at his known addresses by a representative of petitioners' counsel on multiple occasions. Petitioners may provide the requisite showing of proof by submitting a copy of the cover letters transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Additionally, petitioners must show proof that the non-signing inventor refuses to sign the declaration.³ If there is a written refusal, petitioners should submit a copy of that refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

In regards to item (2), the declaration filed with the application papers appears to be a copy of the declaration filed in Application No. 09/129,028, of which the present application

²MPEP 409.03(e).

³Id.

is a continuation-in-part (CIP) application. An oath or declaration from a prior application may only be filed in a continuation or divisional application.⁴ A newly executed oath or declaration must be filed in any continuation-in-part application.⁵ Therefore, petitioners must file a new oath or declaration covering the present application.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Counsel's deposit account, No. 06-1050, will be charged the \$130.00 fee for consideration of this petition.

Telephone inquiries related to this decision should be directed to Petitions Attorney Douglas I. Wood at 703-308-6918.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

⁴See 37 CFR 1.63(d).

⁵37 CFR 1.63(e).